



Paper No. 8

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**FEB 28 2003**

**OFFICE OF PETITIONS**

**ON PETITION**

DORITY & MANNING, P.A.  
POST OFFICE BOX 1449  
GREENVILLE SC 29602-1449

In re Application of  
Chuang, Kaufman, Hsu  
Application No. 09/577,461  
Filed: May 24, 2000  
Attorney Docket No. KCX-157 (14661)  
For: TISSUE IMPULSE DRYING

This is a decision on the petition under 37 CFR 1.47(a), the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, and the petition under 37 CFR 1.137(b), all filed August 15, 2002.

The petition under 37 CFR 1.47(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

The petition under 37 CFR 1.181(a) is also **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a) and 1.137(b)". Failure to respond will result in abandonment of the application. Extensions of time are available and will be governed by 37 CFR 1.136(a).

The instant petition was filed in response in to the "Notice to File Missing Parts of Nonprovisional Application" (the "Notice"), mailed July 19, 2000, which indicated that proper oath or declarations for the named inventors had not been filed, that a surcharge of \$130.00 was due consequently. The Notice set forth an extendable period for reply of two months from its mailing date. No response was received within the allowable period and the application became abandoned on September 20, 2000.

**TREATMENT UNDER 37 CFR 1.47(a)**

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,
- (4) a statement of the last known address of the non-signing inventor.

The instant petition lacks item (1) above.

As to item (1), Section 409.03(d) of the *Manual of Patent Examining Procedure* (MPEP) provides guidance as to what will suffice as sufficient proof that the non-signing inventor cannot be reached as is alleged in the instant petition. This section states, in pertinent part, as follows:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the Nonsigning inventor should be included statement of facts.

While the petition indicates that the non-signing inventor is out of the country and cannot be reached, petitioner did not provide a statement describing petitioner's diligent efforts to locate the non-signing inventor. Any renewed petition filed must be accompanied by a statement that complies with Section 409.03(d) of the MPEP.

#### **TREATMENT UNDER 37 CFR 1.137(b)**

A grantable petition under 37 CFR 1.137(b) requires:

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy item (1) above.

In order for a petition under 37 CFR 1.137(b) to be considered grantable, petitioner must file a proper reply to the Notice to File Missing Parts of Nonprovisional Application. A proper reply would be either, a declaration executed by all named inventors, or a grantable petition under 37 CFR 1.47(a); neither was provided. Any renewed petition filed must include a proper reply to the Notice to File Missing Parts of Nonprovisional Application.

#### **TREATMENT UNDER 37 CFR 1.181**

Section 711.03(c)(II) of the *Manual of Patent Examining Procedure* ("MPEP") provides that in order to establish non-receipt of an Office action so as prove that the imposition of a holding of abandonment is improper, petitioner must: 1) provide a statement to the Office indicating that the Office action was not received by petitioner; 2) include in the statement an attestation to the fact that a review of the file jacket and docket records maintained by petitioner indicates that the Office action was not received; and 3) provide a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

The instant petition does not meet the item (2) and (3). Petitioner must provide a statement as described above and a copy all relevant docket records in order for a renewed petition under 37 CFR 1.181(a) to be considered grantable.

While it is noted that the application file does not contain a hard copy of the Notice of Missing Parts of Nonprovisional Application, Office computer records do reflect the notice was sent to the address of record

on July 19, 2000. It will be assumed that the notice was mailed, absent evidence from petitioner to the contrary.

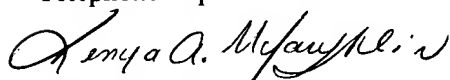
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, DC 20231

By FAX: (703) 308-6916  
Attn.: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 South Clark Place  
Arlington, Virginia

Telephone inquiries should be directed to the undersigned at (703) 305-0010.



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